

#13  
MB  
05/30/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

MAY 25 2001

In re application of:

GERARD *et al.*

Appl. No.: 09/245,025

Filed: February 5, 1999

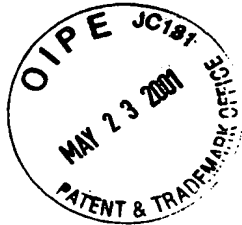
For: **Compositions and Methods for  
Reverse Transcription of Nucleic  
Acid Molecules**

Art Unit: 1652

Examiner: Tung, P.

Atty. Docket: 0942.4330003/RWE/BJD

TECH CENTER 1600/2900



**Reply to Notice to Comply with Requirements for  
Patent Applications Containing Nucleotide Sequence and/or  
Amino Acid Sequence Disclosures**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In reply to the Notice dated April 24, 2001 (Paper No. 12), requiring submission of a computer readable form of the Sequence Listing in the above-referenced patent application, Applicants hereby submit a copy of the PTO date-stamped postcard evidencing the filing of a Request to Open New Disk File concurrently with the captioned application on February 5, 1999, and resubmit a copy of the Utility Patent Application Transmittal, and the Request to Open New Disk File.

Applicants believe that the Notice was issued in error, and that the documents submitted herewith clearly evidence this oversight by the U.S. Patent and Trademark Office. Therefore, reconsideration and withdrawal of the Notice is respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are

necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036. A duplicate copy of this Reply is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono  
Attorney for Applicants  
Registration No. 42,473

Date: May 23, 2009

1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005  
(202) 371-2600

P:\USERS\BRIAND\0942\4330003\05212001,reply to seq req.wpd

# COPY

Due Date: N/A

Applicant: GERARD *et al.*

Art Unit: To be assigned

Examiner: To be assigned

Application No.: To be assigned (Divisional of U.S. Appl.  
No. 09/064,057)

Docket: 0942.4330003

Atty: RWE/BID

Filed: Herewith

For: **Compositions and Methods for Reverse Transcription of Nucleic Acid Molecules**

When receipt stamp is placed hereon, the USPTO acknowledges receipt of the following documents:

1. Utility Patent Application Transmittal (Form PTO/SB/05); 2. Fee Transmittal (Form PTO/SB/17) (*in duplicate*); 3. U.S. Divisional Patent Application entitled: **Compositions and Methods for Reverse Transcription of Nucleic Acid Molecules** and naming as inventors: Gary F. GERARD, Michael D. SMITH and Deb K. CHATTERJEE, the application consisting of: a. A specification containing: (i) 116 pages of description prior to the claims, including a sequence listing at pages 108-116; (ii) 16 pages of claims (115 claims); (iii) a one (1) page abstract; (iv) 54 sheets of drawings: (Figures 1-54); 4. Copy of the Declaration for Patent Application, executed by the inventors in the parent application; 5. Preliminary Amendment; 6. Authorization To Treat A Reply As Incorporating An Extension Of Time Under 37 C.F.R. § 1.136(a)(3) (*in duplicate*); 7. Request to Open New Disk File; 8. Our Check No. 23597 in the amount of \$1,120.00, to cover: \$760.00 utility filing fee; \$126.00 fee for excess total claims; and \$234.00 fee for excess independent claims; and 9. Two (2) return postcards.

**PLEASE AFFIX RECEIPT DATE STAMP AND RETURN POSTCARD TO OUR COURIER**

Box: Patent Application

Please type a sign(+) inside this

PTO/SB/05 (2/98)

Approved for use through 09/30/2000. OMB 0651-0032  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**UTILITY PATENT APPLICATION TRANSMITTAL**  
(Only for new nonprovisional applications under 37 CFR § 1.53(b))

Attorney Docket No.	0942.4330003/RWE/BJD
First Inventor or Application Identifier	GERARD
Title	Compositions and Methods for Reverse Transcription of Nucleic Acid Molecules
Express Mail Label No.	

**APPLICATION ELEMENTS**  
See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO: Assistant Commissioner for Patents  
Box Patent Application  
Washington, DC 20231

1. ☒ \* Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original, and a duplicate for fee processing)
2. ☒ Specification [Total Pages 133]  
(preferred arrangement set forth below)
  - Descriptive title of the Invention
  - Cross References to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to Microfiche Appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
3. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 4]
4. ☒ Oath or Declaration [Total Pages 2]
  - a. ☐ Newly executed (original or copy)
  - b. ☒ Copy from a prior application (37 CFR 1.63(d)) (for continuation/divisional with Box 17 completed)  
[Note Box 5 below]
    - i. ☐ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR §§ 1.63(d)(2) and 1.33(b).
5. ☒ Incorporation By Reference (useable if Box 4b is checked)  
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

6. ☐ Microfiche Computer Program (Appendix)
7. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
  - a. ☐ Computer Readable Copy
  - b. ☒ Paper Copy (identical to computer copy)
  - c. ☐ Statement verifying identity of above copies

**ACCOMPANYING APPLICATION PARTS**

8. ☐ Assignment Papers (cover sheet & document(s))
  9. ☐ 37 CFR 3.73(b) Statement ☐ Power of Attorney  
(when there is an assignee)
  10. ☐ English Translation Document (if applicable)
  11. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
  12. ☒ Preliminary Amendment
  13. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)
  14. ☐ \*Small Entity Statement(s) ☐ Statement filed in prior application, Status still proper and desired  
(PTO/SB/09-12)
  15. ☐ Certified Copy of Priority Document(s)  
(if foreign priority is claimed)
  16. ☒ Other: 37 C.F.R. § 1.136(a)(3) Authorization  
☒ Other: Request to Open New Disk File
- \*NOTE FOR ITEMS 1 & 14: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.27), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).

17. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment:

☐ Continuation ☒ Divisional ☐ Continuation-in-Part (CIP) of prior application No: 09/064,057

Prior application information: Examiner Whisenant, E. Group/Art Unit: 1634


**18. CORRESPONDENCE ADDRESS**

☐ Customer Number  
or Bar Code Label

(Insert Customer No. or Attach bar code label here)

or ☒ Correspondence  
address below

NAME	STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.				
	Attorneys at Law				
ADDRESS	Suite 600, 1100 New York Avenue, N.W.				
CITY	Washington	STATE	DC	ZIP CODE	20005-3934
COUNTRY	USA	TELEPHONE	(202) 371-2600	FAX	(202) 371-2540

NAME (Print/Type)	Brian J. Del Buono	Registration No. (Attorney/Agent)	42,473
SIGNATURE		Date	February 5, 1999

Burden Hour Statement: this form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

GERARD et al.

Appl. No. (To be assigned; Divisional of  
U.S. Appl. No. 09/064,057)

Filed: (Herewith)

For: **Compositions and Methods for  
Reverse Transcription of Nucleic  
Acid Molecules**

Art Unit: (To be assigned)

Examiner: (To be assigned)

Atty. Docket: 0942.4330003/RWE/BJD

**Request to Open New Disk File**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants request that a new disk file be opened for the above-cited application. The Sequence Listing disk submitted on April 22, 1998, in the parent, U.S. Application No. 09/064,057, filed April 22, 1998, contains the identical sequence information as that in the present application.

Respectfully submitted,

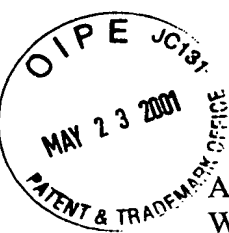
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono  
Agent for Applicants  
Registration No. 42,473

Date: February 5, 1999

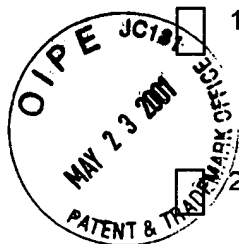
1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600



# **NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):



- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: \_\_\_\_\_

## **Applicant Must Provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

**PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR REPLY**